



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,497	10/15/2003	Thomas J. Bachinski	12929.1072USC1	9051

7590 07/29/2004

Robert A. Kalinsky
MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, MN 55402-0903

EXAMINER

BASICHAS, ALFRED

ART UNIT	PAPER NUMBER
----------	--------------

3749

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,497

Applicant(s)

BACHINSKI ET AL.

Examiner

Alfred Basichas

Art Unit

3749

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/03/04 (preliminary amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/03/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 24, 25, 27, 29, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by McCarthy (IE 80484B3), which shows all of the claimed limitations. McCarthy shows a fireplace with a proximity warning system including an electronic fire guard sensor (1) is typically located on or underneath the mantelpiece of a fireplace (2) or may be located in an alternative position as long as this does not prohibit its operation and the area coverage of the device. The sensor comprises a local oscillator/transmitter arrangement when generating and transmitting a signal setting up a field (3) around the sensor and the fireplace and is preferably a microwave signal although it could be an infrared signal. Once the sensor is operating and the field is established, any motion caused for instance by a person or object moving in the protected zone and disturbing the field, causes an alarm to be activated, i.e. an audio and/or visual alarm. While some of the actual structural components recited in claim 15

Art Unit: 3749

are not specifically discussed, this structure is inherent to the performance of the shown invention.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 26, 28, 30, 35, 37, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy (IE 80484B3). McCarthy discloses substantially all of the claimed limitations as discussed above, but does not specifically disclose a plurality of modules, varying the size of the zone, or that the given temperature be an unsafe temperature.

As regards the plurality of modules, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a plurality of modules into the invention disclosed by McCarthy, since it has been held that

Art Unit: 3749

to provide duplicate parts for multiplied effect is not the type of innovation for which a patent is granted. *St. Regis Paper Co. v. Bemis Co., Inc.*, 193 USPQ 8, 11.

As regards varying the size of the zone, Official Notice is given that a detection system having a detection zone and means for varying the zone is old and well known in the art to allow the user a choice in the size of the area for which detection is necessary or desired. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated means for varying the zone into the invention disclosed by McCarthy, so as to provide for a desired detection area size.

As regards the requirement that the given temperature be an unsafe temperature, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the claimed temperature into the invention disclosed by McCarthy, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable values involves only routine skill in the art. *In re Aller*, 105 USPQ 233. It should be further noted that the entire premise behind the instant invention is to warn of unsafe temperatures for a fireplace. Simply stated, the whole point of any fireplace warning system is to avoid unsafe temperatures, be it for personal safety or structural integrity of the premises. As the prior art already teaches the claimed invention for a given temperature, it is clearly obvious, if not wholly inherent that the temperature at which the alarm engages be one that would be that which is desirous to avoid, at least for any extended period.

Double Patenting

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 29, 31-34, and 38 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 10-13, 14, and 15, respectively, of prior U.S. Patent No. **6,672,860**. This is a double patenting rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alfred Basichas whose telephone number is 703 306 3476. The examiner can normally be reached on Monday through Friday during regular business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus can be reached on 703 308 1935. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9306.

Art Unit: 3749

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0861.

June 28, 2004



Alfred Basicas
Primary Examiner
703 306 3476